

REMARKS

The present amendment is in response to the Final Office Action mailed in the present case on 01/18/2003. In the action the independent claims are all rejected under 35 U.S.C. 103(a) over Lawler, of record. Applicant will deal with just the rejection of the independent claims in this response, as these claims are quite clearly patentable to the applicant over the art of record, and the rejections are faulty; which renders all of the independent claims as patentable as well

The applicant's position throughout the prosecution has been, and continues to be, that the prior art does not teach or suggest associating commands with displayable indicia at a head end, or more broadly at any station remote from a set top box where future programming information is updated and streamed to a user (to the set top box), and including these displayable indicia associated with commands in the future programming information as is claimed. The Examiner in the rejections continues, however, to cite language from the Lawler reference that uses similar words to applicant's claims, and avers that the reference actually teaches the claimed limitations.

Applicant must at this point admit to considerable frustration. Applicant's undersigned representative has had several conversations and other communications with Examiner Prieto on the language and meaning of the references, which communications have been polite, respectful, and in depth. The representative believes the Examiner is making a good faith effort, but may not understand the reference for what it actually teaches, and may just be reluctant to allow the case, suspecting that Lawler may actually read on the case even though it is not clear how.

Claim 16 in this case recites:

16. (Previously Amended) In a system for providing future programming information, in which system displayable indicia are pre-associated with commands at a head end and provided as a part of the future programming information in a displayable data stream, a set top box, comprising;
a broadband receiver to receive the displayable data stream;
circuitry to select the future programming information, including the displayable indicia, and to cause it to be displayed; and
user-operable apparatus to select the displayable indicia;
characterized in that, in response to selecting the displayable indicia, the command associated with the selected displayable indicia is executed.

Considerable effort has been expended to amend the language for this claim so the limitations are starkly clear, and the issues in prosecution are equally clear. For example the claim language clearly and unarguably recites that a displayable indicia already associated with a command at a head end is received in a data stream to the set top box along with future programming information. Further the claim language makes it clear that the displayable indicia associated with a command, received together from the head end in the live data stream along with the future programming information, is displayed along with the programming information. Then when one selects the indicia, the command is invoked.

It is our experience that to reject the claim under the rules and practice of the Office, it is incumbent on the Examiner to show clearly that the reference reads on all of the limitations. And again for the record, the most important limitation is whether or not the art of Lawler teaches **associating commands with displayable indicia in a data stream at a head end, such that the displayable indicia will be displayed with the data stream, and the command will be invoked when the displayable indicia is selected.**

Applicant contends that if Lawler does not teach this limitation, then the claim is clearly patentable to the applicant. The issue is that simple, It need not get bogged down in anything more complicated than this.

In the present action the Examiner, in the Response to Arguments section beginning at the top of page 7 responds directly to applicant's assertion that Lawler does not teach that displayable indicia are associated with commands at the head end in Lawler and provided as part of future programming in a displayable data stream. This is a promising start. The Examiner goes on to provide what she believes are four instances in Lawler teaching the claimed limitation. These are taken one-at-a-time below:

(1) The Examiner's first argument:

"...prior art teaches displayable indicia from server (30) including reminder/record tags, i.e. displayable indicia associated with commands executable when selected (128, 130, 132, 134, 138, or 140) (col 4, lines 11-22, Figs 6 and 8-9, and provided as part of the program time guide (future programming information)."

In response:

(a) The Service and Application server of Lawler Is undeniably a server at the head end (12).

(b) The element numbers 128, 130, 132, 134, 138 and 140 are clearly displayable indicia associated with commands, and are shown in Lawler's Figs. 5, 6, 8, 9 and 10 in menus of Current Show Options, Future Show Options, Past Show Options, Remind Options and Record options.

(c) The description in Lawler relied upon at col 4, lines 11-22 describes service and application server 30 in general terms, and ends with this

language: "This database may be used to store, as described below, reminder tags and record tags set by various users of the system."

(d) The Examiner in her argument states unequivocally that the elements 128, 130, 132, 134, 138 and 140 are the reminder tags and record tags mentioned in Col 4, lines 20-22. This assertion by the Examiner is **SIMPLY UNTRUE**. It would seem that the Examiner could recognize, firstly, that the Lawler portion cited and relied upon in this instance says that "This database may be used to store, as described below, reminder tags and record tags set by various users of the system." Even if the reminder tags and record tags were, in fact, the elements the Examiner claims them to be, **which they certainly are not**, the language relied upon says they may be **stored** in the server. The reference relied upon is completely silent on associating a displayable indicia with a command at server 30, which is what is claimed.

(e) In fact, the Reminder tags and Record tags stored at server 30 are made and stored in response to a user selecting one of the elements the Examiner wants to equate to the tags. See for example col. 12, lines 29-30 from Lawler: "The user can set a record tag by activating the record button 130 in the future programs option menu." See also col. 12, lines 58-61: "A record tag can be thought of as a request to the system to record a program. Each record tag is associated with a program to be recorded and the viewer station or user that set the record tag." It should be abundantly clear that the tags in the passage of Lawler relied upon by the Examiner are not displayable indicia associated with commands. They are tags set as a result of selecting one of the displayable indicia at the user's end. See further Fig. 4A of Lawler. In step 208 the system retrieves the Program Specific Information (PSI) from the head end and stores it in memory. This only happens at system initialization. The PSI is not displayed in real time as in applicant's system. Further, it is clear from this diagram and the associated text that the displayable elements 128, 130, 132, 134, 138 and 140, associated with commands, are in menus that must be called from memory to be used. They are not displayable indicia

associated with commands at the head end, which are a part of the data stream including the program information, **as claimed.**

(2) The Examiner's second argument:

"The prior art includes displayable indicia from server (32) including on-demand digitized video information including video clips (i.e displayable indicia associated with commands) executable when selected (128, 130, 132, 134, 138, or 140) (col 4, lines 24-35) and provided as part of future programming information, Figs. 3 and 6."

In response:

(a) The Examiner states unequivocally that the video clips referenced are displayable indicia associated with commands as claimed, and says that these video clips are in fact the elements 128, 130, 132, 134, 138, or 140. This, just like in (1) above, is simply an untrue statement. The text relied upon to make this untrue assertion is col 4, lines 24-35, which states: "The continuous media servers (32) provide storage and on-demand or near on-demand delivery of digitized video information. The digitized video information can include video programming of substantially any duration ranging from individual image frames and brief video clips to full-length motion pictures. The continuous media servers could be used to store programs recorded at the head end 12 in response to a record tag. The recorded program could then be provided to the user that set the record tag, at the user's request, over the network 14. If more than one user set a record tag for the same program, all could access a single stored recording from the continuous media servers 32.

Applicant, as usual, searches this passage completely in vain for any teaching relevant to associating a displayable indicia (an icon for example) with a command (an action). The Examiner evidently still wants the record

tags to be the display elements 128, 130, 132, 134, 138, or 140, which they certainly are not.

(3) The Examiner's third argument:

The Examiner states unequivocally that the art teaches "...displayable indicia from server (34) includes (future) program schedule information, also including a link to a video preview or close caption (i.e. displayable indicia associated with commands executable when selected (col 4, lines 36-51), preview window (110), icons and record/reminder tags, and provided as a part of the future programming information, col 8, lines 35-53, Figs. 3 and 6.

In response:

(a) in this rationale the Examiner equates a **link** to a video preview or close caption as the claimed displayable indicia associated with a command. In the passages relied upon a link to a video preview is introduced in col 4 and a preview window is described in col 8. There is, however, no description or teaching that the link is in fact a displayable indicia as claimed, nor is there any description about how one might select a displayable indicia to cause a preview to be shown in the preview window 110. There is no teaching here of associating a command with a displayable indicia at the head end, or of selecting the displayable indicia at the user's end to invoke the command associated with the displayable indicia.

(4) The Examiner's fourth argument:

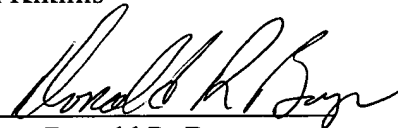
The Examiner seems to be arguing in this part that the program grid itself is the displayable indicia associated with a command. The section col. 7, lines 20-63 relied upon merely describes the program grid and its tiles. Col 9,

lines 52-58 merely describes program time guide parameters added to the grid. How this gets to be displayable indicia associated with a command is not at all clear. It is, in fact, not. Col 10, line 9 relied upon simply says that the current time and date are set. Again, how does this read on the claimed limitations? Col 8 lines 5-17 relied upon describes how a focus frame is indicated on a program grid, which, again, is completely silent on the issue of displayable indicia associated at the head end with commands. Lastly, col 10 lines 25-50 relied upon describes menus called up from memory, which menus may certainly have displayable indicia associated with commands, as is always the case with menus, but begs the issue of associating such indicia with commands at the head end and streaming them to be displayed with the program information.

In summary, the art, regardless of imaginative interpretation by the Examiner, just does not teach displayable indicia associated with commands at the head end, which indicia, displayed with the programming information, when selected, causes the associated command to be invoked. That is what is claimed as a limitation. And that is what must be found in the art to lawfully reject the claims.

The applicant is forced to conclude that the Examiner either misunderstands the claimed limitations or the art of Lawler.

Respectfully Submitted,
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